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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/613,741 | 07/03/2003 | John C. S. Koo | 31045-101 | 5633 |

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| EXAMINER | |
|---|---|
| STASHICK, ANTHONY D | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3728 | |

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/613,741 | KOO, JOHN C. S. | |
| | Examiner | Art Unit | |
| | Anthony Stashick | 3728 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *29 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

*2.* Claims 1-3, 5, 11-12, 19-20 and 24-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Kester et al. 4,356,643. Kester '643 discloses all the limitations of the claims including the following: a shoe (see Figure 2) comprising a bottom surface (bottom of 11) that is adjacent to the ground in normal use and that has a plurality of indentations (that located between projections 14), with lower extending portions 14 between the indentations (see Figure 2); a sole 11 that forms at least a portion of the bottom surface; an upper portion 13 extending above the sole; a plurality of small particles 18 bonded (see col. 2, lines 16-19) to at least some of the lower extending portions (see Figure 2); at least a portion of each of the plurality of indentations is not coated with the small particles (see Figure 5, portions between portions 18 are not small particle bonded to the indentations); at least 1,000 small particles are bonded to the at least some lower extending portions (see Figure 3); the small particles are bonded to the at least some of the lower extending portions using adhesive material (see col. 2, lines 16-19); the small particles comprises a fabric material (18 is made of nylon material, a fabric material); the small particles have been bonded directly onto the at least some of the lower extending portions (see Figures 2 and 3); the sole is sufficiently durable for commercially acceptable outdoor use (see col. 2, lines 20-31); the sole includes an outsole that is comprised of at least one of leather, natural rubber and synthetic

rubber (see col. 1, lines 43-49); the small particles cover at least 50% of the portion of the bottom surface that normally comes into contact with the ground (see Figures 1-3); the sole is sufficiently strong for commercially acceptable outdoor use (see col. 1, lines 4-47); the bottom surface has at least five indentations (see Figure 2); at least some of the indentations are very narrow (see potion at front edge of heel); at least one of the indentations is approximately 1-2 millimeters in width (see indentations in forefoot area); at least some of the indentations are closely spaced (see First two indentations at front edge of heel in Figure 2); at least two of the indentations are separated from each other by no more than approximately 2 millimeters (see first two indentations at front edge of heel).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kester et al. 4,356,643 as applied above in view of Knoche et al. 6,782,642. Kester et al. '643 as applied above discloses all the limitations of the claim except for the small particles being bonded to at least some of the lower extending portions by embedding the small particles directly into the bottom surface using at least one of heat and pressure. Knoche et al. '643 teaches that particles attached to the bottom of a sole can be placed in a molded and pressed or embedded into the sole to help hold the particles on the sole to gain traction. Therefore, it would have been obvious,

tone of ordinary skill in the art at the time the invention was made, to embed the particles of Kester et al. '643 into the sole surface to aid in holding the particle to the surface to aid in gaining traction.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kester et al. 4,356,643 as applied to claim 5 above in view of Giese, Jr. 2,663,097. Kester et al. '643 as applied to claim 5 discloses all the limitations of the claim except for the fabric particles being applied by a flocking technique. Giese, Jr. '0097 teaches that particles can be attached to the sole of a shoe by flocking to help gain traction on slippery surfaces. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to flock the particles onto the bottom sole of the shoe to help hold the particles onto the bottom of the shoe to gain traction, as taught by Giese, Jr.

6. Claims 7-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Kester et al. 4,356, 643 as applied to claim 1 above in view of Official Notice. Kester et al. '643 as applied to claim 1 above discloses all the limitations of the claims except for the for the particle material being made of natural or synthetic leather, natural or synthetic rubber, plastic, Official Notice is taken that it is well known within the art of anti-slip material to use natural or synthetic leather, natural or synthetic rubber or plastic particles to prevent slipping of one surface on another. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to make the particles of Kester et al. '643 as applied to claim 1 out of natural or synthetic leather, natural or synthetic rubber, or plastic as these materials are well known and used in the art for aiding in slip prevention.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kester et al. 4,356,643 as applied to claim 1 above in view of Bible 4,779,360. Kester et al. '643 as applied to claim 1 above discloses all the limitations of the claim except for the particles comprising metal. Bible '360 teaches that grit material used to gain grip on slippery surfaces can be made of aluminum oxide, silicon carbide or tungsten carbide (i.e. metals) for their durability, less tendency to crumble and their hardness to scratch or furrow up metallic slippery surfaces. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the grit particles of Kester et al. '643 out of metal, as taught by Bible '360, to aid in gaining grip on metallic or rough surfaces.

8. Claims 13-18 are rejected under 35 U.S.C. 103(a) as being obvious over Kester et al. 4,356,643 as applied to claim 1 above. Kester et al. '643 discloses all the limitations of the claims except for the ASTM tear resistance and abrasion resistance requirements. It appears that since these requirements are standards, it would be well within the skill of one of ordinary skill in the art to make a sole to meet these requirements. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the sole of Kester et al. '643 meet the tear and abrasion resistance standards.

9. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kester et al. 4,356,643 as applied to claim 1 in view Schaffer et al. 5,276,981. Kester et al. '643 discloses all the limitations of the claims except for the particle wearing off over certain time frames. Schaffer et al. '981 teaches that the material for particles attached to the bottom of shoe soles to aid in gaining traction can be modified to wear over given time frames, including weeks (see col. 2, lines 3-21). Therefore, it would have been well within the skill of one of ordinary skill in the

art, to modify the material of the particles attached to the sole of Kester et al. '643 to last over any time period desired, as taught by Schaffer et al. '981, to determine the wear life of the sole of the shoe.

### *Response to Arguments*

10. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments and the declaration filed have been considered but are moot in view of the new grounds of rejections set forth above.

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

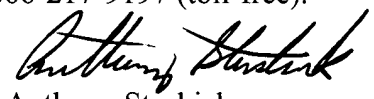
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick
Primary Examiner
Art Unit 3728

ADS